

REMARKS

This amendment is submitted in response to the final action mailed November 16, 2004. Favorable reconsideration of the application, as amended, is respectfully requested.

Claims 8, 9 and 53 were rejected under 35 U.S.C. 103(a) as being unpatentable over Schult (U.S. 4,911,975) in view of Yap et al. (U.S. 6,037,398) and Wilkes (U.S. 4,609,696). Applicants respectfully submit that the claims are nonobvious over the cited references.

The Examiner stated that one of ordinary skill in the art would be motivated to substitute the asphalt-based material of Yap et al. for the polymer-based upper cover layer of Schult in order to provide the same function at a lower cost. The Examiner noted that a lower cost composition for the cover layer in Schult contains 5% asphalt.

Applicants respectfully submit that one of ordinary skill in the art would be motivated against using much more than 5% asphalt in the composition, not motivated for using an asphalt-based composition. In the Background of the Invention, Schult describes several drawbacks of the previous roofing materials having an upper sealing layer of black polymer bitumen (polymer-modified asphalt). Schult describes his invention as using a polymer-based upper cover layer that avoids the drawbacks of the asphalt upper sealing layers of the prior art. The example made with 5% asphalt at lower cost would not motivate one of ordinary skill in the art to use a much greater amount of asphalt in the composition; rather, this example suggests that it is acceptable to use up to about 5% asphalt for lower cost while still retaining the benefits of the invention, but that the use of much more asphalt than 5% would be detrimental to the invention. The examples in Yap et al. disclose compositions containing about 48% asphalt if the solvent is removed as suggested by the Examiner. One of ordinary skill in the art would certainly not be motivated to use such a large percentage of asphalt in the upper cover layer of Schult, in view of teaching that asphalt has disadvantages and the suggestion that asphalt may be used in only a limited amount without harming the performance of the invention.


To substitute the asphalt-based material of Yap et al. for the polymer-based upper cover layer of Schult would not be a modification of the Schult invention, but rather it would be a totally different invention. Schult repeatedly indicates that the

keys to the invention are to use a light-colored upper cover layer, preferably white-colored, and to use a polymer-based upper cover layer. The Yap et al. material is black-colored, not light-colored; it is the complete opposite of the invention described in Schult. Moreover, the Yap et al. material is asphalt-based, not polymer-based, which again is completely different from the Schult invention. One of ordinary skill in the art would be motivated against these modifications which totally change the nature of the invention.

New claims 58 and 59 state that the roofing material further comprises a layer of surface granules embedded in the top portion of the coating. Schult teaches away from the use of such granules to protect the upper surface of the roofing material (see col. 1, lines 24-54). Yap et al. and Wilkes do not disclose such granules. Therefore, it is respectfully submitted that claims 58 and 59 are patentable over the prior art. The Examiner is respectfully requested to enter the new claims because they are believed to be in condition for allowance. Further, it is believed that the claims present no new issues requiring further consideration or search because the Examiner has already considered roofing materials having a layer of granules embedded in the top coating since they are described as the typical embodiment of the invention at page 1, lines 20-21, and because the Examiner's previous search included roofing materials having surface granules.

If any questions should arise with respect to the amendments or the above remarks, or if it would in any way expedite the prosecution of this application, it is requested that the Examiner contact Applicants' attorney at the number listed below. If any fees are due in connection with the filing of this amendment, including any fee for a required extension of time under 37 CFR 1.136(a) for which Applicants hereby petition, please charge all necessary fees to deposit account no. 50-0568.

Respectfully submitted,



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